

1 RECORD OF ORAL HEARING

2 UNITED STATES PATENT AND TRADEMARK OFFICE

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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
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10 Ex parte RANDALL G. SMITH and TIMOTHY J. MARTEL
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13 Appeal 2007-3134
14 Application 09/746,754
15 Technology Center 2800
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18 Oral Hearing Held: October 24, 2007
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22 Before JOHN C. MARTIN, HOWARD B. BLANKENSHIP, and
23 JOHN A. JEFFERY, Administrative Patent Judges
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25 ON BEHALF OF THE APPELLANTS:

26
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31 The above-entitled matter came on for hearing on Wednesday,
32 October 24, 2007, commencing at 9:00 a.m., at the U.S. Patent and
33 Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia,
34 before Sean Williams, Notary Public.

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1 JUDGE MARTIN: Good morning, counsel.

2 MR. RASHIDI-YAZD: Good morning.

3 JUDGE MARTIN: Let me spell your last name for the court
4reporter's benefit.

5 MR. RASHIDI-YAZD: R-A-S-H-I-D-I - Y-A-Z-D.

6 JUDGE MARTIN: Thank you. You can proceed whenever you're
7ready.

8 MR. RASHIDI-YAZD: Good morning, Your Honor. First of all, on
9behalf of the Appellant, (indiscernible) Corporation, I'd like to thank you for
10your time to hear our oral argument on this case. Although the briefs, I
11believe, stand on their own, I think we need to take a little bit of time and
12hopefully explain the case in a little more detail.

13 Based on how you'd like me to proceed, I can either take questions at
14the outset or sort of give a background of what we're going after in the
15claims.

16 JUDGE MARTIN: Proceed.

17 JUDGE JEFFERY: Go ahead.

18 MR. RASHIDI-YAZD: Well, we're lucky today. We have a
19whiteboard right here, although it's not electronic. As pretty much
20everyone's aware, a whiteboard is basically a way of providing indicia, for
21example, to a classroom. So in the case here we have a whiteboard to my
22right that one could write on with a dry erase marker. Well, unfortunately,
23you can't copy that, scan it, print it for, for example, an audience or a
24classroom.

25 We move forward to an electronic whiteboard which has a computer
26that displays a projector that projects an image onto the surface of the

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1electronic whiteboard enabling one to now save indicia that you have stored
2-- typed onto the whiteboard or touched by the whiteboard surface.

3 In order to sync the computer to the electronic whiteboard, there has
4to be some type of calibration or a means of being sync or oriented
5(indiscernible). As a result, we're getting closer to our invention. Our
6invention is not claiming a calibration system or a method. It is one step that
7precedes. That happens to be the initiation of the calibration process.

8 This case was originally allowed over the (indiscernible) reference.
9After some antics from a competitor of ours it was withdrawn. The
10Examiner has taken the position that a step that comes before what we have
11defined as the calibration process in our application is sufficient to reject us
12under 102. We maintain that Step 4 of their 7 step process which is on page
1327 to 28 of the 1998 Smart Manual that we have referred to is their step of
14initiation or step that begins the calibration process. The calibration process,
15as it's claimed in Claim 41, requires three steps, a projection of the GUI or
16some type of GUI onto the electronic whiteboard surface, a detection of
17touches of the electronic whiteboard surface, and then some type of
18calculation or communication between the electronic whiteboard and the
19computer in order to calibrate the two.

20 JUDGE JEFFERY: But, counsel, let me ask you about the calibration
21process --

22 MR. RASHIDI-YAZD: Yes, sir.

23 JUDGE JEFFERY: -- as it's defined.

24 MR. RASHIDI-YAZD: Sure.

25 JUDGE JEFFERY: Doesn't the claim, by using the word "includes"
26-- you say the calibration process "includes," and then you --

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1 MR. RASHIDI-YAZD: Which claim are you referring to?

2 JUDGE JEFFERY: -- recite a step. Doesn't that not preclude other
3 steps that aren't necessarily claimed in the calibration process? You're not
4 strictly limited to the steps that you recited in the claim as corresponding to
5 the calibration process.

6 MR. RASHIDI-YAZD: Which claim are you referring to
7 specifically?

8 JUDGE JEFFERY: Well, Claim 41.

9 JUDGE BLANKENSHIP: Claim 41.

10 MR. RASHIDI-YAZD: 41? Okay.

11 JUDGE JEFFERY: In line 3 of Claim 41 --

12 MR. RASHIDI-YAZD: Yes.

13 JUDGE JEFFERY: -- you say now wherein in the calibration process
14 includes --

15 MR. RASHIDI-YAZD: Okay.

16 JUDGE JEFFERY: -- the steps, so on, projecting an image, so on and
17 so forth.

18 MR. RASHIDI-YAZD: Sure.

19 JUDGE JEFFERY: What I'm asking is that certainly -- we're not
20 saying the calibration process "consists of" --

21 MR. RASHIDI-YAZD: Correct.

22 JUDGE JEFFERY: -- these steps so as to provide a narrower
23 recitation of the calibration process. It clearly -- it seems to me, it could
24 include other steps.

25 MR. RASHIDI-YAZD: I agree it could, but the way that we've
26 defined it in the specification via a lexographer, we have defined the

1calibration process to include those three specific steps. On top of it, when
2this case was originally allowed, the Examiner required that we include
3those three limitations that identified the calibration.

4 JUDGE JEFFERY: Well, fair enough. Let's go to the definition that
5you point out --

6 MR. RASHIDI-YAZD: Sure.

7 JUDGE JEFFERY: -- in your briefs.

8 MR. RASHIDI-YAZD: Sure.

9 JUDGE JEFFERY: As I understand it, you're defining the calibration
10process on -- I think you cited page 5 of the specification. Lines 11 through
1124 --

12 MR. RASHIDI-YAZD: Yes, sir.

13 JUDGE JEFFERY: -- I think were mentioned.

14 MR. RASHIDI-YAZD: Yes.

15 JUDGE JEFFERY: Is there really an express definition? I
16understand this is clearly a description of the calibration process for an
17electronic whiteboard. No problem there.

18 MR. RASHIDI-YAZD: Okay.

19 JUDGE JEFFERY: The question that I have is, is that an express
20definition of a calibration process so as to limit the interpretation of that
21term in the claims to only that particular process?

22 MR. RASHIDI-YAZD: I believe by bringing this definition to the
23claims it is. I believe we have expressly claimed that the calibration process
24is three steps. We have invented a step that precedes that. That is using the
25computer.

26 JUDGE JEFFERY: But the calibration process as claimed "includes"

1those three steps?

2 MR. RASHIDI-YAZD: Sure, yes.

3 JUDGE JEFFERY: I mean you didn't say "consisting of" those three
4steps.

5 MR. RASHIDI-YAZD: Correct, we did not.

6 JUDGE JEFFERY: Nor do I see -- I mean you're not coming out in
7the specification and saying I define "calibration" as this, I define "initiating
8the calibration process" as this, whatever it is. I see descriptions. I see just a
9description of the process. I'll leave it at that. I'm just pointing out the briefs
10repeatedly mentioned defining these terms and I, frankly, don't see it and
11unless I'm missing something here, let me know. What I see is a description,
12however.

13 MR. RASHIDI-YAZD: Well, that said, I think the way that the
14Examiner -- she is interpreting the initiation of calibration because we're
15saying calibration is in the prior art. We're not claiming the calibration
16process itself. I think the initiation stuff is the important part of the crux of
17our argument, that initiation must occur (indiscernible) the computer.
18Initiation, as we've defined it -- I think we have adequately defined in our
19application "initiation." It is that step that projects the GUI onto the
20whiteboard, and that's why I think the Examiner in this case required that we
21include the calibration process, identifying 1, 2 and 3 into our claim. So
22since it's (indiscernible) claim, the calibration process, I think, is -- you
23know, we're not claiming the calibration process.

24 JUDGE JEFFERY: Well --

25 MR. RASHIDI-YAZD: I'm sorry to interrupt you, but the calibration
26itself we admit is replete in our --

1 JUDGE JEFFERY: Sure, and they're (indiscernible) claims that --

2 MR. RASHIDI-YAZD: Yes (indiscernible), correct.

3 JUDGE JEFFERY: I wanted to ask you about the cited prior art
4reference --

5 MR. RASHIDI-YAZD: Yes.

6 JUDGE JEFFERY: -- and the orientation of the whiteboard --

7 MR. RASHIDI-YAZD: Yes.

8 JUDGE JEFFERY: -- is really a key element of this. I take it that
9Step 1 is not disputed, it can occur at the whiteboard.

10 MR. RASHIDI-YAZD: Yes, it can occur --

11 JUDGE JEFFERY: I can press a button at the whiteboard and I get
12something happening with respect to the calibration process.

13 MR. RASHIDI-YAZD: Yes, Your Honor. We admit to such I
14believe both in our appeal brief and our reply brief as such.

15 JUDGE JEFFERY: Yes. Let me ask you one question about the
16display aspect of that Step 1 --

17 MR. RASHIDI-YAZD: Correct.

18 JUDGE JEFFERY: -- because at the end of the step --

19 MR. RASHIDI-YAZD: Step 1 you're referring to?

20 JUDGE JEFFERY: Just prior to Step 2.

21 MR. RASHIDI-YADI: Yes, sir.

22 JUDGE JEFFERY: You got a display of a dialog box.

23 MR. RASHIDI-YAZD: Yes.

24 JUDGE JEFFERY: Now does that occur at the whiteboard or at the
25computer or both?

26 MR. RASHIDI-YAZD: We don't know. We don't know. Their prior

1art does not explain such. The Examiner appears to maintain a position that
2that display, which I would argue would be at the computer, a display of --
3projection occurs at the whiteboard.

4 JUDGE JEFFERY: Okay. Well, let me just clarify here because in
5the reply brief on page 8 --

6 MR. RASHIDI-YAZD: Okay. Let me find that.

7 JUDGE JEFFERY: -- you say that -- let me find it here. At the very
8stop on the first -- essentially the first sentence of page 8 on the reply brief
9you say as part of the manual completing Step 1, which Appellant concedes
10can occur distant a computer, means the user has still three more steps. So
11you're saying that completing Step 1 at the whiteboard, which -- somewhere
12distant the computer, essentially ends prior to the display of the dialog box.

13 MR. RASHIDI-YAZD: Yes, yes.

14 JUDGE JEFFERY: Okay

15 MR. RASHIDI-YAZD: But, again, the prior art does not describe
16such, so we have to go with what we can read from the 35 pages that we
17have from the manual. So we classify the art as such, correct.

18 JUDGE JEFFERY: I guess another question that I would pose to you
19is because we have this open-ended language with respect to the calibration
20process, why couldn't the calibration process begin at Step 2 of the
21reference? That is to say Step 2 requires previewing the respective
22orientation levels. Doesn't that -- is that part of a calibration process, the fact
23that I'm selecting these options?

24 MR. RASHIDI-YAZD: Where does it occur? They require a click
25which I would maintain is at the computer.

26 JUDGE JEFFERY: Correct, but the critical issue in the case is the

1 initiation of the calibration has to occur distant the computer, right?

2 MR. RASHIDI-YAZD: Yes, sir, correct.

3 JUDGE JEFFERY: What I'm getting at is we've already conceded
4 that Step 1 occurs distant the computer.

5 MR. RASHIDI-YAZD: Correct.

6 JUDGE JEFFERY: There's no dispute there.

7 MR. RASHIDI-YAZD: Yes, no dispute.

8 JUDGE JEFFERY: So if Step 2 is part of the calibration process, then
9 it seems to me we've met the claim. What I'm getting at here is that the
10 claim -- Claim 41 anyway. I'm not necessarily speaking about the other
11 claims.

12 MR. RASHIDI-YAZD: Okay.

13 JUDGE JEFFERY: Claim 41 just merely says the calibration process
14 "includes" these steps.

15 MR. RASHIDI-YAZD: Okay.

16 JUDGE JEFFERY: It doesn't -- there's no closed language here. So
17 why couldn't the calibration process include Step 2?

18 MR. RASHIDI-YAZD: Well, as we were defining the calibration
19 process, the first step of the calibration process we described is the
20 projection of a GUI onto the whiteboard which is Step 5. It's the way that
21 we've defined the calibration process and claim such, design (indiscernible)
22 Step 5.

23 JUDGE JEFFERY: Okay.

24 MR. RASHIDI-YAZD: Moving forward, regarding the independent
25 claims which, as we mentioned in our reply brief, that the Examiner failed to
26 explain any of his allegations on why they should be rejected. He came back

1with a -- assuming that now Your Honor does not allow or believe that 41 is
2allowable -- we think at least remote control device such that initiating the
3calibration process distant the computer is not taught by the prior reference.

4 JUDGE JEFFERY: Why couldn't a button on the whiteboard be a
5remote control device, at least with respect to functions with respect to the
6computer? I mean if I click on the whiteboard either with my finger or I
7push a button, whatever, isn't that controlling a process remotely with
8respect to the computer?

9 MR. RASHIDI-YAZD: I would argue it could, but I don't think in
10this case -- the remote control device, I think, would be the reasonable
11interpretation of a remote control device. It would not fall underneath that
12umbrella.

13 JUDGE MARTIN: You want us to construe that to mean a handheld
14remote control?

15 MR. RASHIDI-YAZD: Yes. Do you have any further questions or
16shall I continue?

17 JUDGE MARITN: No. Actually that's all we have. Okay. No
18further questions.

19 MR. RASHIDI-YAZD: All right. As the Appellant's counsel, we
20thank you for your time.

21 JUDGE MARTIN: Thank you. That concludes the hearing in Appeal
222007-3134.

23(Whereupon, the proceedings concluded.)